

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DIGITAL CHECK CORP. d/b/a ST IMAGING,
Petitioner,

v.

E-IMAGEDATA CORP.
Patent Owner.

Case IPR2017-00177
Patent 8,537,279 B2

PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION

Patent Trial and Appeal Board
United States Patent and Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

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LIST OF EXHIBITS

Number	Brief Description
2001	6/6/2013 Information Disclosure Statement submitted by applicant, Application Serial No. 13/560,283
2002	6/17/2013 List of References cited by applicant and considered by examiner, Application Serial No. 13/560,283
2003	6/25/2013 Notice of Allowance and Fee(s) Due, Application Serial No. 13/560,283
2004	11/4/2016 Claim Construction Order, Dkt. No. 38, <i>e-ImageData Corp. v. Digital Check Corp.</i> , Civil Action No. 16-cv-576, E. D. Wis.

I. THE BOARD SHOULD NOT INSTITUTE *INTER PARTES* REVIEW.

The Board should deny ST Imaging's Petition for *inter partes* review of U.S. Patent No. 8,537,279 for both procedural and substantive defects.

First, the Office has already found the '279 Patent patentable over the same or substantially the same references that ST Imaging relies upon. The Examiner considered Fujinawa, the primary reference for both grounds of the Petition. The Examiner also considered Watanabe and teachings substantially similar to those of Kokubo.

Second, ST Imaging advances multiple alternative grounds for the challenged claims but provides no meaningful distinction between them. Presenting redundant grounds is contrary to the Board's precedent and ST Imaging's obligation to present its best case in a petition for *inter partes* review.

Third, ST Imaging improperly used the '279 Patent as a roadmap for putting together the various elements of the claimed invention. ST Imaging demonstrates its impermissible hindsight reconstruction by failing to articulate any reason why one of skill in the art would have made the proposed modifications.

Fourth, as the Office already determined, the teachings of the prior art references do not render the claims obvious. Specifically, ST Imaging's proposed modifications to Fujinawa's device would render it unsuitable for its intended

purpose while violating longstanding principles of mechanical design and adding needless complexity to an otherwise simple design.

For at least the foregoing reasons, ST Imaging's Petition should be denied in its entirety.

II. THE BOARD SHOULD DECLINE TO CONSIDER ST IMAGING'S GROUNDS AND REFERENCES BECAUSE THEY ARE CUMULATIVE AND REDUNDANT.

A. The Cited Art Is Cumulative Of Prior Office Proceedings.

The Board should exercise its discretion not to institute *inter partes* review because the references cited in the Petition are the same or substantially the same prior art considered by the Examiner during prosecution of the '279 Patent.

Institution of an *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.108. The Board may decline to institute an *inter partes* review when “the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). When an Examiner had already considered the prior art at issue, it is not an efficient use of the Board's or parties' resources to adjudicate a dispute on an already-considered issue. *Nu Mark LLC v. Fontem Holdings I, B.V.*, IPR2016-01309, Paper No. 11 at *12–13 (P.T.A.B. Dec. 15, 2016). This is true even where the Examiner did not specifically address a prior art reference in an Office Action. *See id.*

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